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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,248	03/08/2001	Thomas E. Chefalas	YOR920000718US1 (14031)	5564
7590	08/25/2005		EXAMINER	
Richard L. Catania Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			NELSON, FREDA ANN	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/802,248	Applicant(s) CHEFALAS ET AL.	
	Examiner Freda A. Nelson	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,10-14,16-19 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,10-14,16-19 and 22-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

This is in response to a communication filed August 11, 2005 wherein: the applicant has amended claims 1, 11, 19, 31, and 33;

Claims 12-14 and 16-18 have been withdrawn;

Claims 2, 6-9, 15, and 20-21 have been canceled;

Claim 36 has been added; and

Claims 1, 3-5, 10-14, 16-19, and 22-36 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-5, 10, 19, 22, 24-25, 27-28, 31, 33, and 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. (US PG Pub. 2001/0025245) in view of Thomson et al. (US PG Pub. 2003/0061104).

In claims 1 and 10, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019). Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web

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browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

Flickinger et al. does not disclose said customer information transmitted to the server of said manufacturer to allow the customer to verify and update the product registration information and the customer information. Flickinger et al. does not further disclose completing a product registration of said one or more products when the customer verifies and updates said product registration information and said customer information. Thomson et al. disclose that the electronic warranty administrator then sends the purchaser a welcoming email that includes the warranty administrator's URL (which will enable the customer to access the warranty administrator's home page, as displayed in FIG. 17), plus login instructions and a password which will enable the customer to access their personalized home page (FIG. 3); and the customer is also asked to verify the accuracy of the customer profile in possession of the electronic warranty administrator and to up-date or correct as needed (paragraph 0053). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Thomson et al. so a customer can correct information as needed in order to keep their information as accurate as possible.

In claim 3 and 22, Flickinger et al. discloses that a method for automatically registering an asset as part of a purchasing transaction for that asset (paragraph 0008).

In claim 4, Flickinger et al. disclose that an example of how the E-registrar is provided to the vendor manufacturer is by a 'drag and drop' E-registrar icon, or alternatively as a file or other unit which can be sent across the network to the manufacturer and the purchaser would send his personal E-registrar via his web browser or email, which would contain standard information needed for registering the asset, to the manufacturer (paragraph 0036).

In claim 5, Flickinger et al. disclose that the electronic file contains data specific to the purchasing entity, including such information as would typically be requested for registration of an asset (e.g., name, address, and marketing information) wherein the data in the E-registrar is extracted by the purchasing transaction application, the credit approval application, or another application activated by one of the parties to the transaction (paragraph 0009).

In claims 19 and 27-28, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019).

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Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

Flickinger et al. does not disclose said customer information transmitted to the server of said manufacturer to allow the customer to verify and update the product registration information and the customer information. Flickinger et al. does not further disclose completing a product registration of said one or more products when the customer verifies and updates said product registration information and said customer information. Thomson et al. disclose that the electronic warranty administrator then sends the purchaser a welcoming email that includes the warranty administrator's URL (which will enable the customer to access the warranty administrator's home page, as displayed in FIG. 17), plus login instructions and a password which will enable the customer to access their personalized home page (FIG. 3); and the customer is also asked to verify the accuracy of the customer profile in possession of the electronic warranty administrator and to up-date or correct as needed (paragraph 0053). Thomson et al. still further disclose that still further advantages of the invention are the automatic registration of a warranty at the point of sale or through the activation of a cash card magnetically encoded with product information at an Automated Teller Machine (ATM), on the Internet, or by phone, and the ability to acquire point-of-sale information via the Internet (paragraph 0017). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Thomson et al. so a customer can correct information as needed in order to keep their information as accurate as possible.

In claims 23 and 34, Flickinger et al. disclose that the electronic file contains data specific to the purchasing entity, including such information as would typically be requested for registration of an asset (e.g., name, address, and marketing information (paragraph 0009)). Flickinger further discloses that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data

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on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021). Flickinger does not disclose that utilizing a telephone number to retrieve customer information, however, it is old and well-known in the business art that telephone numbers are used to retrieve customer information. It is old and well-known that grocery stores and department stores use customer telephone numbers in lieu of smart cards to retrieve customer information in order to give customers discounts. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger to include the feature telephone number feature as another means to retrieve customer information.

In claims 24 and 35, Flickinger et al. disclose that in the case of some assets which are purchased at a retail outlet or on-line, the purchaser is asked to register the asset on-line via an Internet connection and in either case, the user must perform the product or warranty registration manually (i.e., fill out the card by hand and mail it or log onto the Internet and enter the requested information).

In claim 25, Flickinger et al. disclose that the purchaser would send his personal E-registrar via his web browser or email, which would contain standard information needed for registering the asset, to the manufacturer wherein the manufacturer would extract the pertinent information from the E-Registar and register the product, and the registration process would be accomplished. The manufacture would provide verification of registration and other information (e.g. warranties) either on the spot through the browser or email, or subsequently through other means, such as mail or facsimile (paragraph 0036).

In claim 31, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019). Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

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Flickinger et al. does not disclose said customer information transmitted to the server of said manufacturer to allow the customer to verify and update the product registration information and the customer information. Flickinger et al. does not further disclose completing a product registration of said one or more products when the customer verifies and updates said product registration information and said customer information. Thomson et al. disclose that the electronic warranty administrator then sends the purchaser a welcoming email that includes the warranty administrator's URL (which will enable the customer to access the warranty administrator's home page, as displayed in FIG. 17), plus login instructions and a password which will enable the customer to access their personalized home page (FIG. 3); and the customer is also asked to verify the accuracy of the customer profile in possession of the electronic warranty administrator and to up-date or correct as needed (paragraph 0053). Thomson et al. still further disclose that still further advantages of the invention are the automatic registration of a warranty at the point of sale or through the activation of a cash card magnetically encoded with product information at an Automated Teller Machine (ATM), on the Internet, or by phone, and the ability to acquire point-of-sale information via the Internet (paragraph 0017). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Thomson et al. so a customer can correct information as needed in order to keep their information as accurate as possible.

In claim 33, Flickinger et al. discloses a method for electronic registration of assets in a registration database, using E-registrar which can be applied for both to online purchases and to conventional purchases (paragraph 0019). Flickinger et al. further discloses an example in which an asset created by a manufacturer (122) is purchased from the seller (120) using a credit card and the third party credit card company (140) provides the asset registration database (130) (paragraph 0028; FIG. 3). Flickinger et al. further disclose that during or at the conclusion of a transaction to purchase an asset, the seller (120) prompts the purchaser (110) to register the asset being purchased (paragraph 0023). Flickinger et al. still further disclose that the purchaser-specific data file, called an E-registrar, can be an electronic file on a storage media that is accessible to a purchaser's computer (e.g., integrated into the OS or web browser, smart card reader), or could be maintained by a third party (e.g., credit card company website where purchaser creates and updates his E-registrar file via the Internet); and the data on this electronic file can be extracted during the purchasing transaction (e.g., point-of-sale (POS), online) or can be extracted in a separate transaction initiated by the purchaser after the purchasing transaction (paragraph 0021).

In claim 36, Flickinger et al. disclose that the re-seller would provide the service of registering the purchased item with the manufacturer for and on behalf of the purchaser (paragraph 0038).

2. Claims 11, 29-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. (US PG Pub. 2001/0025245) in view of Thomson et al. (US PG Pub. 2003/0061104), still in further view of Dovolis (US PG Pub. 2001/0034609).

In claims 11, 29-30 and 32, Flickinger does not disclose that at least one web page allows said customer to indicate that the product is a gift to a donee. Dovolis discloses a simple and effective method for registering warranty information at the point of purchase (paragraph 0013). Dovolis further discloses that the system monitors the duration of the warranty period for each product so that a consumer may later visit the site to see when their warranty expires, to transfer warranties from one person to another if the product is given as a gift, and to view product instructions and other information available online for that particular product (paragraph 0013). Dovolis still further disclose that the system provides a means for consumers to view their purchases on a consumer web page and to personalize their consumer page so as to categorize their products in any way that makes sense to them (paragraph 0013). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Dovolis in order to allow warranties to be transferred to from one person to another as is done with automobiles and homes.

3. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. in view of Thomson et al. (US PG Pub. 2003/0061104), still in further view of Byrd et al. (Patent Number 6,069,941).

In claim 26, Flickinger et al. does not disclose that the server associated with the manufacturer comprises a voice response unit server. Byrd et al. disclose that as part of the prompt to the subscriber 12, the active one of the VRUs 24 and 25 or the PC server 26 also provides an option to allow the subscriber to register the product (col. 6, lines 25-27). Byrd et al. further disclose that the information entered by the subscriber 12 in connection with product registration is typically stored in a transcription VRU 46 within the call platform 20 having the capability of recording the subscriber-entered registration information; and the registration information stored in the transcription VRU 46 may be accessed by a customer transcriber 50 (i.e., a computer maintained by the product manufacturer) that communicates with the call platform 20 by calling a pre-assigned POTS routed to the switch 16 (col.6, lines 35-46). It would have been



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obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Flickinger et al. to include the feature of Byrd et al. in order to allow consumers to an alternative option to contact the manufacturer's server.

### ***Response to Amendment and Arguments***

In response to applicant's arguments that in claims 1, 19, 31 and 33, Flickinger et al. does not teach or suggest the recitation "to allow the customer to verify and update the product registration information and the customer information", the examiner asserts that allowing and action is different from actually performing the action.

In response to applicant's arguments that in claims 11, 29-30, and 32, Flickinger et al. does not teach or suggest the recitation that "the at least one webpage allows said customer to indicate that the at least one product is a gift to a donee", the examiner asserts that allowing and action is different from actually performing the action.

In response to applicant's argument that in claim 26, Flickinger et al. or Byrd does not teach or suggest the invention recited in applicant's independent claim 19, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

4. The examiner has cited prior art of interest, for example:

1) Goodman, Jay, "Manufacturers Receive Online Warranty Card Data", March 2, 2000, Business Wire. New York, pg. 1.

2) "eWarrantyCard.com Simplifies Collection of Warranty Card Information", February 2000, Direct marketing, v62, n10, p66.

3) "eWarrantyCard.com Announces Warranty Card Solution", December 1999, Business Wire.

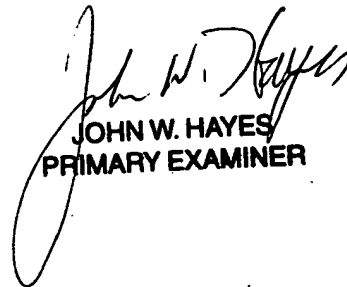
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free):

FAN 08/19/2005

A handwritten signature in cursive script, appearing to read "Nedra Nelson".A handwritten signature in cursive script, appearing to read "John W. Hayes".  
**JOHN W. HAYES**  
**PRIMARY EXAMINER**